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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,035	04/30/2001	Brian T. Murren	GE1-009US	5206

21718 7590 03/16/2004

LEE & HAYES PLLC  
SUITE 500  
421 W RIVERSIDE  
SPOKANE, WA 99201

EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/847,035

Applicant(s)

MURREN ET AL.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 11-18, 20, 21, 23-26 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fisher et al. Fisher et al disclose a method and system for processing and transmitting electronic auction information including an information tracking component comprised of the merchandise description database 30 and the bid database 31, a supply component comprised of bid form 20 and bid validator 21, a publishing component comprised of the e-mail notification disclosed in col. 8, lines 18-20 and col. 9, lines 36-47 and a subscriber request component 29 that receives requests and modifies the information in the bid database. Re claim 3, claiming that the information stored is regarding a plurality of services is only a

statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Re claims 13 and 15 Fisher et al disclose transmitting additional information to the users such as the query in col. 10, lines 18-21 asking if the bidder will accept less than the requested items.

3. Claims 30-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fisher et al. Fisher et al disclose a method and system for processing and transmitting electronic auction information including a database 30 that maintains information describing a plurality of different assets, bringing up items for auction communicates different groups of the information to different ones of the subscribers, bidding from the subscribers is receiving an indication from one of the

subscribers to purchase an item, sending e-mail notification of higher bids to all the other subscribers is communicating a change in status of the asset to the other subscribers.

4. Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Freivald et al. Freivald et al disclose a change detection tool where users register by submitting an e-mail address and a URL of the desired document. The users select portions of the document of interest to them. The change detection server 20 monitors all the portions of the documents and notifies the users of changes in the portions of the documents that the users indicated as being of interest, see col. 7, lines 1-55. Re claim 37, claiming that the update status is a sold or sale pending status is only a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as

compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9, 10, 22, 27 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al in view of Lawrence. Fisher et al disclose all the features of the applicants' claimed invention except means to indicate that an item is not for sale. Lawrence discloses an auction system with hold buttons 64, 98 and 170 for indicating that auction of an item is halted. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Lawrence to provide the system of Fisher et al with means to indicate that an item is not currently for sale.

8. Claims 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al in view of Anderson et al. Fisher et al disclose all the features of the applicants' claimed invention except requiring fees from the users. Anderson et al disclose an auction system that requires fees from users to reduce the cost of items. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Anderson et al to provide the system of Fisher et al with means to charge the users fees in order to reduce the cost of the items.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fjb

  
F. J. BARTUSKA  
PRIMARY EXAMINER 3/10/04